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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO..	CONFIRMATION NO.
10/076,440	02/19/2002	David A. Caughey	132-03 US	9855

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EXAMINER
AILES, BENJAMIN A

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/076,440	CAUGHEY, DAVID A.
	Examiner	Art Unit
	Benjamin A. Ailes	2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _24 March 2006_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-17_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-17_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _03242006_.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the Amendment filed 24 March 2006. This action is non-final.

2. Claims 1-17 remain pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection. Examiner has corrected the rejection format as pointed out by applicant on page 11 of Remarks filed 24 March 2006. The Examiner deems the claim rejections proper for review by applicant and regrets the error. Examiner has chosen to address key arguments presented by applicant.

4. (A) Applicant argues on page 8 of the Remarks that the combination of Gropper and Schiller is unmotivated and that there is no suggestion or motivation to combine Gropper and Schiller. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gropper clearly teaches a contact information database and Schiller clearly teaches a method for updating a contact information database, therefore the examiner maintains that one of ordinary skill in the art would have been motivated to combine the teachings

in order to provide an up to date contact information database as outlined below and by

Schiller, page 2, paragraph [0021].

5.   (B) Applicant argues with respect to claim 6 on page 9 of the Remarks that

Gropper does not teach the step of "verifying the authenticity of each electronic

message received at a system of the new contact". The examiner respectfully

disagrees. Taking broadest reasonable interpretation, the claim limitation is a check to

make sure that contents of a message, in this case the message containing personal

information, is correct. Gropper teaches on this aspect by teaching that a user can

perform change of address operations in col. 6, lines 54-57.

6.   (C) Applicant argues with respect to claim 9 on pages 9-10 of Remarks that

Gropper and Schiller do not teach the aspect of "using an automated reply filter

cooperatively in execution with the electronic message application, intercepting the

received electronic message prior to storage thereof within an inbox of the electronic

message application". Examiner respectfully disagrees. Schiller does teach on this

aspect by way of utilizing aspects of Microsoft Outlook (see figures 3 and 5 of Schiller)

which is deemed well known for utilizing reply messages which teaches on the aspect of

using an automated reply filter.

7.   Applicant's arguments fail to comply with 37 CFR 1.111(b) with respect to claim

11 because they amount to a general allegation that the claims define a patentable

invention without specifically pointing out how the language of the claims patentably

distinguishes them from the references.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gropper (U.S. 6,883,000 B1) in view of Schiller (U.S. 2001/0032089 A1).

10.   Regarding claim 1, Gropper discloses a method of adding a new contact to an

electronic contact information database comprising the steps of:

        (a) recognizing data stored in an electronic contact information database of a

user system as data relating to contact information of a new contact (col. 5, lines

16-29, Gropper discloses a method of a user entering in a person or business'

contact information using a Universal Contact Locator (UCL), which may be a

person's e-mail address (see col. 4, lines 43-56). The client program

automatically recognizes when a new contact's information is entered and stores

the entered UCLs in a list.);

        (b) extracting from the stored data a contact destination of the new contact (col.

5, lines 37-41, Gropper discloses a method of extracting the UCL of the new

contact. The UCL providing information relating to the contact's contact

destination.);

        (c) automatically sending a message including a request for additional contact

information to the contact destination of the new contact. Gropper discloses a

method wherein once the client station connects to the Internet the client station

sends a request to the server for additional contact information linked to the

contact's UCL (col. 5, lines 37-45) but does not explicitly disclose the request for

additional contact information being sent directly to the new contact. However,

Schiller discloses an operation of a contact database wherein update requests

are sent in the form of electronic messages directly to the contact's email

address in order for the contact to be able to provide updated information. One

of ordinary skill in the art at the time of the applicant's invention would have found

it obvious to implement the step of sending a message directly to a contact

requesting updated information as disclosed by Schiller in combination with the

contact management database disclosed by Gropper. One of ordinary skill in the

art would have been motivated to implement this step in order for a user to be

able to have an up to date contact database that is constantly being updated by

the best person, the best person being the person who updates information in

respect to themselves (see Schiller, page 2, paragraph [0021]).; and

(d) upon receiving a return message including additional contact information

form the new contact, automatically updating the contact information database

with the additional contact information (col. 5, line 63 – col. 6, lines 4, Gropper

discloses the method wherein the server system sends a message back

containing the appropriate information (the contact's additional contact

information). Once this information has been received at the client, the contact

data is stored in the appropriate locations (i.e. CMS, PIM).).

11.   Claims 14, 15, and 16 contain similar subject matter and are rejected under the same rationale as claim 1 above.

12.   Claim 9 contains similar subject matter and is rejected under the same rationale as claim 1. Regarding the use of an inbox the method of storing messages within the inbox, Schiller discloses the use of an e-mail application to send and receive electronic messages (see figures 3 and 5, i.e. Microsoft Outlook), therefore it is deemed inherent for the e-mail application to include an e-mail inbox as is well known in the art.

13.   Regarding claim 2, Gropper and Schiller teach the method wherein the stored data is provided manually by the user (Gropper, col. 5, lines 16-23, Gropper discloses a method wherein a user enters information about a new contact manually into a computer.).

14.   Regarding claim 3, Gropper and Schiller teach the method wherein the stored data is provided automatically by an electronic message application in execution on the user system (Gropper, col. 5, lines 37-45, Gropper discloses a method wherein once the client station connects to the Internet the client station sends a request to the server for additional contact information linked to the contact's UCL. col. 5, line 63 – col. 6, lines 4, Gropper discloses the method wherein the server system sends a message back containing the appropriate information (the contact's additional contact information). Once this information has been received at the client, the contact data is stored in the appropriate locations (i.e. CMS, PIM).).

15.   Regarding claim 4, Gropper and Schiller teach the method wherein the message is an electronic message and wherein step d) includes the step of:

automatically extracting the additional contact information from the received

return electronic message (Gropper, col. 5, line 63 – col. 6, lines 4, Gropper discloses

the method wherein the server system sends a message back containing the

appropriate information (the contact's additional contact information). Once this

information has been received at the client, the contact data automatically extracted and

is stored in the appropriate locations (i.e. CMS, PIM).).

16.   Regarding claims 5 and 17, Gropper and Schiller teach the method wherein the

user is a subscriber to a contact list update service and wherein the new contact is other

than a subscriber to the contact list update service (Gropper, col. 4, line 64 – col. 5, line

3, Gropper discloses the method wherein the user is a subscriber to the contact list

update service (see col. 5, lines 10-15) and the 'new contact' does not have to be a

subscriber to the service, wherein the subscriber can also use the client program as a

general 'personal address book'.).

17.   Regarding claim 6, Gropper discloses the ability for a user to verify personal

information and update information accordingly (i.e. change of address, see col. 6, lines

54-57) but does not explicitly, as stated above in the rejection of claim 1, the step of

requesting for additional contact information being sent directly to the new contact.

However, Schiller discloses an operation of a contact database wherein update

requests are sent in the form of electronic messages directly to the contact's email

address in order for the contact to be able to provide updated information. The user

then either updates contact information or returns the message with a message

confirming that no update is necessary. One of ordinary skill in the art at the time of the

applicant's invention would have found it obvious to implement the step of sending a

message directly to a contact requesting updated information as disclosed by Schiller in

combination with the contact management database disclosed by Gropper. One of

ordinary skill in the art would have been motivated to implement this step in order for a

user to be able to have an up to date contact database that is constantly being updated

by the best person, the best person being the person who updates information in

respect to themselves (see Schiller, page 2, paragraph [0021]).

18.   Regarding claim 7, Gropper and Schiller teach the method wherein the electronic

message comprises message body text containing contact information for at least one

contact information field for verification. (Gropper, col. 5, lines 16-29, Gropper discloses

a method wherein an electronic message is sent comprising a UCL code sent to the

server system for verification.).

19.   Regarding claim 8, Gropper and Schiller teach the method wherein the return

message is generated by an automated reply filter in execution on the contact system

using contact information retrieved from a memory accessible to the automated reply

filter (col. 5, lines 48-51, Gropper discloses the method wherein a request for contact

information is submitted to a server system and the server system automatically

retrieves the requested contact information and submits the information back to the

requesting system.).

20.   Regarding claim 10, Gropper and Schiller teach the method wherein the return

message is generated by an automated reply filter in execution on the contact system

using contact information retrieved from a memory accessible to the automated reply

filter (Gropper, col. 5, lines 48-51, Gropper discloses the method wherein a request for contact information is submitted to a server system and the server system automatically retrieves the requested contact information and submits the information back to the requesting system.).

21.   Regarding claim 11, as mentioned in above in the rejection of claim 9, Schiller discloses the use of an e-mail application to send and receive electronic messages (see figures 3 and 5, i.e. Microsoft Outlook), therefore it is deemed inherent for the e-mail application to include an e-mail inbox as is well known in the art. It is also deemed inherent for e-mail applications to have the ability to store electronic messages in separate folders (i.e. new, trash, deleted, old...).

22.   Regarding claim 12, Gropper discloses the method comprising the steps of:

receiving the transmitted new electronic message at the user system (col. 5, lines 48-51, Gropper discloses the contact information being transferred to the user system);

automatically extracting from the received new electronic message the current contact information for the new contact (col. 5, lines 66 – col. 6, line 2, Gropper discloses the client program stores appropriate contact data to appropriate locations).

automatically storing the extracted current contact information in association with other contact information relating to the new contact within the contact database of the user system (col. 5, line 66 – col. 6, line 4, Gropper discloses storing contact data in appropriate locations (contact manager databases, i.e. PIM).

23.   Claim 13 contains similar subject matter and is rejected under the same rationale

as claims 9 and 12.

Conclusion

24.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Stern et al. (US 7,054,886 B2) discloses a method for maintaining people and

   organization information.

Polnewow et al. (US 5,813,006) discloses an online directory service with registration

   system.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-

3899. The examiner can normally be reached on M-F 6:30-4, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

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Business Center (EBC) at 866-217-9197 (toll-free).

baa

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